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| 10/529,390 | 03/28/2005 | Michael Porat | 05035 | 6737 |
| 23338 7590 07/09/2008 DENNISON, SCHULTZ & MACDONALD 1727 KING STREET SUITE 105 ALEXANDRIA, VA 22314 | | | | |
| EXAMINER | | | | |
| MATTER, KRISTIN CLARETTE | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Office Action Summary

Application No.

10/529,390

Applicant(s)

PORAT, MICHAEL

Examiner

KRISTEN C. MATTER

Art Unit

3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,8-13,15,16,18-20,23,27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,8-13,15,16,18-20,23,27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Action is in response to the amendment filed on 5/13/2008. Claims 1, 6, 12, 16, 27, and 28 have been amended and no claims have been added or cancelled. Currently, claims 1, 2, 6, 8-13, 15, 16, 18-20, 23, 27, and 28 are pending in the instant application.

Claim Rejections - 35 USC § 102/35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 8, 12, 16, 23, and 27, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Richardson (US 6,134,716).

Regarding claims 1, 6, 12, 16, and 27, Richardson discloses a mask that enables one to breathe filtered air comprising a hood (12) that includes a bag of transparent film material impermeable to gases (see column 5, lines 35-40), a filter assembly (18) connected to the bag (column 3, lines 1-20) and exhalation valve (20) worn in the area of a user's nose and/or mouth (see Figure 1), and a separate sealing means (60, 62), not attached/connected to the bag, to seal

around the neck. To the extent, if any, that Richardson does not clearly mention the material is impermeable to gases, Examiner points to the fact that the hood has valves and filters and to column 4, lines 48-49, in which Richardson discloses the strap is for preventing contaminated air from entering the interior of the hood. This seems to clearly indicate that the bag is made of an impermeable film material, but regardless, it is obvious to one of skill in the art to make a hood for protecting against air toxins from a material that is impermeable to gases. The flexible nature of the hood inherently makes the hood foldable to pocket size.

Regarding claim 8, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)(citations omitted). In this case, Richardson discloses the filter member as sealed to the inner surface of the hood (column 3, lines 8-11) but does not specifically state that it is heat sealed (although Richardson does disclose the bag itself is heat-sealed in column 4, line 16). It is well known to persons of ordinary skill in the art to heat seal plastic materials as an effective means for creating air-tight barriers and therefore would have been obvious to one of ordinary skill in the art to heat seal the filter assembly onto the bag.

Regarding claim 23, Richardson does not specifically state that the hood is turned inside out after use, however, the flexible nature of the hood material inherently allows the hood to be turned inside out after removal from the head.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson as applied to claims 1, 6, 8, 12, 16, 23, and 27 above, and further in view of McGuinness (H1316). Richardson does not disclose the hood as being made of a laminate of more than one plastic material. However, McGuinness discloses a similar protective hood formed from plastic laminates of more than one material (see column 2, lines 43-52). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the hood of Richardson from a plastic laminate as disclosed by McGuinness in order to more effectively protect the user from contaminants for extended periods of time. In addition, it appears as though the device disclosed by Richardson would perform equally well with a hood made of a plastic laminate as opposed to a single layer of plastic film.

Claims 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson as applied to claims 1, 6, 8, 12, 16, 23, and 27 above, and further in view of Wen (US 6,681,765).

Regarding claims 9 and 11, Richardson discloses a multilayer filter with active charcoal but is silent as to an antiseptic. Wen discloses, in a respiration mask, a multilayer filter with charcoal and antiseptic agents including clorohexidine (see column 2, lines 55-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided Richardson's filter with an antiseptic agent as taught by Wen in order to more effectively protect the user from viruses and bacteria in the contaminated air. Furthermore, it appears as though the device disclosed by Richardson would perform equally well with the antiseptic layer.

Regarding claim 10, Wen does not disclose that the charcoal is sandwiched between multiple layers of antiseptic agents. However, absent a critical teaching and/or a showing of unexpected results from having a charcoal layer sandwiched between the antiseptic layers, Examiner contends it would have been an obvious design consideration to one of ordinary skill in the art at the time of the invention to have used two antiseptic layers surrounding a charcoal layer in the multilayer filter disclosed by the modified Richardson reference in order to use multiple antiseptic agents for example or for more effective protection against viruses and bacteria. Furthermore, it appears as though the device disclosed by Richardson and Wen would perform equally well with the antiseptic layers sandwiching the charcoal layer.

Regarding claim 13, Richardson does not disclose the particle sizes filtered by the filter. However, it the limitation "greater than 2 microns" includes macroparticles that would inherently be filtered out by the filter of Richardson (i.e., large dust). In any case, Wen discloses that the filter filters out particles in excess of 0.3 microns (column 5, line 60), which overlaps the claimed range of greater than 2 microns. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have designed the filter of Richardson to filter out particles greater than 2 microns in order to prevent contaminants from being breathed in by the user.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson as applied to claims 1, 6, 8, 12, 16, 23, and 27 above, and further in view of Courtney (US 4,981,134). Richardson does not disclose the valve as being embedded in the filter. However, Courtney discloses a filter assembly for a face mask that includes an exhalation valve (7)

embedded in the filter assembly (see Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a filter assembly as taught by Courtney in the mask of Richardson in order to allow the valve and filter to both be easily replaced as needed.

Claims 18-20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson as applied to claims 1, 6, 8, 12, 16, 23, and 27 above, and further in view of Siberell (US 5,263,202).

Regarding claims 18 and 20, Richardson does not disclose that the sealing means is elastic. However, Siberell discloses an elastic drawstring for use in clothing devices (see column 2, line 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the drawstring of Richardson elastic as taught by Siberell in order to provide a snug seal for sealing the neck from contaminants. In addition, the drawstring of Richardson provides a good seal and does not choke the wearer.

Regarding claim 19, Richardson does not disclose 2 drawstrings. However, it is well known to those of ordinary skill in the art that drawstrings are replaceable and therefore it would have been an obvious design consideration to one of ordinary skill in the art at the time of the invention to have provided a second (i.e., spare) elastic drawstring in the mask of Richardson in order to replace the drawstring should it break, for example.

Regarding claim 28, the modified device disclosed by Richardson and Siberell has all of the structural limitations needed to perform the recited method steps, including unfolding the hood and stretching an elastic sealing means over the hood and around the neck, and is fully

capable of doing so. It would have been obvious to one of ordinary skill in the art at the time the invention was made, upon seeing the modified Richardson device, to perform the recited method steps of the instant claim 28.

Response to Arguments

Applicant's arguments filed 5/13/2008 have been fully considered but they are not persuasive.

In response to applicant's arguments that the sealing means of Richardson is attached or connected to the bag, examiner respectfully maintains that because the sealing means is removable, its position with respect to the mask is not fixed (i.e., the sealing means can be slid throughout the sleeve even when being used to secure the mask and can subsequently be removed altogether) and therefore the sealing means can be considered to be not attached/connected to the bag. In addition, the sealing means is fully capable of being used without being inserted through the sleeve (i.e., if the wearer was in a hurry to don the hood and did not have time to thread the sealing means through the sleeve, the sealing means could be placed over the head and secured at any location around the neck of the wearer by securing the holder 62).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. van der Smitten et al. is cited to show another escape mask with a sealing element that does not pass through any piece/sleeve of the mask to secure it to the user.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. MATTER whose telephone number is (571)272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kristen C. Matter/
Examiner, Art Unit 3771

/Justine R Yu/
Supervisory Patent Examiner, Art Unit 3771